

II. REMARKS

Claims 1-35 are canceled without prejudice.

Claim 36 is newly presented for consideration and recites “identifying a topic, comprising: displaying a topic tag for a chat using an instant messaging service that allows a user to send and receive text messages in real time with another user.” Support for these features and limitations may be found at least in the prior claim 16 and Specification paragraphs [0031], [0035], and [0046]. No new matter is entered.

Claim 36 also recites “determining whether the user wants to accept the topic tag.” Support for these features and limitations may be found at least in Specification paragraph [0046]. No new matter is entered.

Claim 36 also recites “responsive to determining that the user does not want to accept the topic tag, determining whether the user wants to distinguish the topic tag.” Support for these features and limitations may be found at least in the prior claim 18 and Specification paragraph [0046]. No new matter is entered.

Claim 36 also recites “responsive to determining that the user wants to distinguish the topic tag, entering a term for the topic tag by the user.” Support for these features and limitations may be found at least in Specification paragraph [0046]. No new matter is entered.

Claim 36 also recites “responsive to entering a term for the topic tag, determining whether the other user accepts the term for the topic tag.” Support for these features and limitations may be found at least in Specification paragraph [0046]. No new matter is entered.

Claim 36 also recites “responsive the other user not accepting the term for the topic tag, using a default topic tag as the topic tag.” Support for these features and limitations may be found at least in Specification paragraph [0046]. No new matter is entered.

Claim 36 also recites “inserting the topic tag into the chat’s text.” Support for these features and limitations may be found at least in Specification paragraph [0043]. No new matter is entered.

Claim 36 also recites “responsive to the user identifying a subtopic tag for the chat, inserting the subtopic tag into the chat’s text.” Support for these features and limitations may be found at least in Specification paragraph [0043]. No new matter is entered.

Claim 36 also recites “determining whether a turn has occurred.” Support for these features and limitations may be found at least in the prior claim 14 and Specification paragraphs [0043] and [0046]. No new matter is entered.

Claim 36 also recites “responsive to determining that a turn has occurred, determining whether a topic shift has occurred.” Support for these features and limitations may be found at least in the prior claim 14 and Specification paragraph [0043]. No new matter is entered.

Claim 36 also recites “responsive to determining that a shift has occurred, repeating the identifying a topic.” Support for these features and limitations may be found at least in the prior claim 15 and Specification paragraph [0046]. No new matter is entered.

Claim 36 also recites “saving a transcript of the chat to a repository in an XML format.” Support for these features and limitations may be found at least in the prior claim 1 and Specification paragraph [0043]. No new matter is entered.

Claim 36 also recites “performing a search of the repository, comprising: determining whether the search will be a full text search.” Support for these features and limitations may be found at least in Specification paragraph [0048]. No new matter is entered.

Claim 36 also recites “responsive to determining that the search will not be a full text search, determining whether the search will be a filtered search.” Support for these features and limitations may be found at least in Specification paragraph [0048]. No new matter is entered.

Claim 36 also recites “responsive to determining that the search will be a filtered search, choosing a filter, wherein types of the filter comprise: a topic tag, a user name, and a date.” Support for these features and limitations may be found at least in Specification paragraphs [0047] and [0048]. No new matter is entered.

Claim 36 also recites “conducting the search.” Support for these features and limitations may be found at least in the prior claim 13 and Specification paragraph [0048]. No new matter is entered.

Claim 36 also recites “determining whether the search was satisfactory.” Support for these features and limitations may be found at least in Specification paragraph [0048]. No new matter is entered.

Claim 36 also recites “responsive to determining that the search was not satisfactory, entering feedback by the user.” Support for these features and limitations may be found at least in the prior claim 21 and Specification paragraph [0048]. No new matter is entered.

Claim 36 also recites “responsive to determining that the user wants to view the full text of a found topic, displaying a segment of the transcript corresponding to the found topic.” Support for these features and limitations may be found at least in Specification paragraph [0048]. No new matter is entered.

Claim 36 also recites “responsive to determining that another search is to be conducted, repeating the performing a search.” Support for these features and limitations may be found at least in Specification paragraph [0048]. No new matter is entered.

Claim 36 also recites “scanning topic tags from the transcript, comprising: comparing a scanned topic tag to an auto alert table.” Support for these features and limitations may be found at least in the prior claims 4-7 and Specification paragraph [0050]. No new matter is entered.

Claim 36 also recites “responsive to determining that there is a match between the scanned topic tag and the auto alert table, determining and executing an action that is associated with the scanned topic tag in the auto alert table.” Support for these features and limitations may be found at least in Specification paragraph [0050]. No new matter is entered.

Claim 36 also recites “wherein the action comprises exporting the transcript to an e-mail.” Support for these features and limitations may be found at least in the prior claims 4-7 and Specification paragraph [0047]. No new matter is entered.

Claim 36 also recites “responsive to determining that there is another scanned topic tag, repeating the scanning topic tags from the transcript.” Support for these features and limitations may be found at least in Specification paragraph [0050]. No new matter is entered.

Claim 36 also recites “wherein bases upon which the determining whether a turn has occurred comprise: an amount of textual data entered; a time period; and successive statements.” Support for these features and limitations may be found at least in Specification paragraphs [0039] and [0043]. No new matter is entered.

Applicant believes that the claimed invention as a whole is outside the scope of the cited art.

Rejection under 35 U.S.C. § 103

Claims 1-10 and 12-35 are canceled, thus the rejections are moot. However since some of the features and limitations of the previous version of the claims are in claim 36, Applicant hereby traverses the rejections with regard to claim 36. In rejecting claims under 35 U.S.C.

§ 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444; *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

Claim 36 comprises several new features and limitations, including:

- responsive to entering a term for the topic tag, determining whether the other user accepts the term for the topic tag; ...
- inserting the topic tag into the chat’s text;
- responsive to the user identifying a subtopic tag for the chat, inserting the subtopic tag into the chat’s text; ...
- responsive to determining that the search will not be a full text search, determining whether the search will be a filtered search; ...
- determining whether the search was satisfactory; ...
- responsive to determining that there is a match between the scanned topic tag and the auto alert table, determining and executing an action that is associated with the scanned topic tag in the auto alert table; ...
- wherein bases upon which the determining whether a turn has occurred comprise:

an amount of textual data entered;
a time period; and
successive statements.

Applicant believes these new features and limitations are outside the scope of the of the combinations of cited art used to reject the prior claims. Therefore, Applicant respectfully requests that the rejection be withdrawn. However since some of the features and limitations of the previous version of the claims are in claim 36, Applicant hereby traverses the rejections with regard to claim 36.

First Ground of Rejection

Claims 1-10 and 12 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent Application Publication No. 2004/0260710 (hereinafter Marston) in view of U.S. Patent Application Publication No. 2004/0249650 (hereinafter Freedman) and U.S. Patent Application Publication No. 2003/0233420 (hereinafter Stark). Final Office Action pp. 3-10. Applicant believes the new features and limitations of claim 36 are outside the scope of the of the combination of cited art, as discussed above.

Additionally, Claim 36 recites “saving a transcript of the chat to a repository in an XML format.” The Examiner rejected limitations similar to these in the Final Office Action. Final Office Action pp.3-4 (rejecting claim 1). In rejecting the similar features of claim 1, the Examiner alleges Marston, at Abstract and paragraphs [0010] and [0018], teaches these limitations. The cited portions of Marston teach an “S-Mail can include and/or resemble ... a message exchanged via an instant messaging system,” yet Marston is silent to a “transcript of [a] chat.” In other words, even if Marston teaches including messages of a chat, *arguendo*, Marston is silent to a transcript of the messages. Freedman and Stark are not relied upon and do not

remedy these deficiencies. Hence, the combination of cited art fails to teach “saving a transcript of the chat to a repository in an XML format.”

Claim 36 also recites “scanning topic tags from the transcript, comprising: comparing a scanned topic tag to an auto alert table.” The Examiner rejected limitations similar to these in the Final Office Action. Final Office Action pp. 7-9 (rejecting claims 4-7). In rejected the similar features of claims 4-7, the Examiner alleges Freedman (para. [0014]) teaches these limitations. Freedman is silent to “comparing a scanned topic tag to an auto alert table.” Marston and Stark are not relied upon and do not remedy these deficiencies. Hence, the combination of cited art fails to teach “scanning topic tags from the transcript, comprising: comparing a scanned topic tag to an auto alert table.”

Claim 36 also recites “wherein the action comprises exporting the transcript to an e-mail.” The Examiner rejected limitations similar to these in the Final Office Action. Final Office Action pp. 7-9 (rejecting claims 4-7). In rejected the similar features of claims 4-7, the Examiner alleges Freedman (para. [0014]) teaches these limitations. Freedman is silent to “exporting the transcript to an e-mail.” Marston and Stark are not relied upon and do not remedy these deficiencies. Hence, the combination of cited art fails to teach “wherein the action comprises exporting the transcript to an e-mail.”

Thus, the claim comprises features and limitations that are outside the scope of the cited art. Therefore, Applicant respectfully requests that the rejection be withdrawn.

Second Ground of Rejection

Claim 13 stands rejected under 35 U.S.C. § 103(a) over U.S. Patent Application Publication No. 2004/0260710 (hereinafter Marston) in view of U.S. Patent Application Publication No. 2004/0249650 (hereinafter Freedman), U.S. Patent Application Publication No.

2003/0233420 (hereinafter Stark), and U.S. Patent Application Publication No. 2006/0277474 (hereinafter Robarts). Final Office Action pp. 10-11. Applicant believes the new features and limitations of claim 36 are outside the scope of the combination of cited art, as discussed above. Therefore, Applicant respectfully requests that the rejection be withdrawn.

Third Ground of Rejection

Claims 14-15 and 29 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent Application Publication No. 2004/0260710 (hereinafter Marston) in view of U.S. Patent Application Publication No. 2004/0249650 (hereinafter Freedman), U.S. Patent Application Publication No. 2003/0233420 (hereinafter Stark), and U.S. Patent Application Publication No. 2005/0021624 (hereinafter Herf). Final Office Action pp. 12-16. Applicant believes the new features and limitations of claim 36 are outside the scope of the combination of cited art, as discussed above.

Additionally, claim 36 recites “responsive to determining that a shift has occurred, repeating the identifying a topic.” The Examiner rejected limitations similar to these in the Final Office Action. Final Office Action pp. 12-13 (rejecting claims 14-15). The Examiner admits Marston, Freedman, and Stark fail to teach the similar limitations and alleges Herf (at para. [0026]) teaches these limitations. Herf teaches “if the snapshot has changed substantially since the previous line in the conversation, this change is indicated with a thumbnail representing the change.” In other words, Herf at best teaches that responsive to determining there is a substantial change, displaying a thumbnail representing the change; yet Herf is silent to “repeating the identifying a topic.” Hence, the combination of cited art fails to teach “responsive to determining that a shift has occurred, repeating the identifying a topic.”

Thus, the claim comprises features and limitations that are outside the scope of the cited art. Therefore, Applicant respectfully requests that the rejection be withdrawn.

Fourth Ground of Rejection

Claims 16-19 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent Application Publication No. 2004/0260710 (hereinafter Marston) in view of U.S. Patent Application Publication No. 2004/0249650 (hereinafter Freedman), U.S. Patent Application Publication No. 2003/0233420 (hereinafter Stark), and U.S. Patent No. 5,615,296 (hereinafter Stanford). Final Office Action pp. 16-19. Applicant believes the new features and limitations of claim 36 are outside the scope of the of the combination of cited art, as discussed above.

Additionally, claim 36 recites “identifying a topic, comprising: displaying a topic tag for a chat using an instant messaging service that allows a user to send and receive text messages in real time with another user.” The Examiner rejected limitations similar to these in the Final Office Action. Final Office Action p.17 (rejecting claim 16). The Examiner admits Marston, Freedman, and Stark fail to teach the similar limitations. Stanford is silent to “with another user.” Hence, the combination of cited art fails to teach “identifying a topic, comprising: displaying a topic tag for a chat using an instant messaging service that allows a user to send and receive text messages in real time with another user.”

Claim 36 also recites “responsive to determining that the user does not want to accept the topic tag, determining whether the user wants to distinguish the topic tag.” The Examiner rejected limitations similar to these in the Final Office Action. Final Office Action p.18 (rejecting claim 18). The Examiner admits Marston, Freedman, and Stark fail to teach the similar limitations. Stanford is silent to “the user does not want to accept the topic tag.” Hence,

the combination of cited art fails to teach “responsive to determining that the user does not want to accept the topic tag, determining whether the user wants to distinguish the topic tag.”

Thus, the claim comprises features and limitations that are outside the scope of the cited art. Therefore, Applicant respectfully requests that the rejection be withdrawn.

Fifth Ground of Rejection

Claim 20 stands rejected under 35 U.S.C. § 103(a) over U.S. Patent Application Publication No. 2004/0260710 (hereinafter Marston) in view of U.S. Patent Application Publication No. 2004/0249650 (hereinafter Freedman), U.S. Patent Application Publication No. 2003/0233420 (hereinafter Stark), and U.S. Patent No. 7,034,691 (hereinafter Rapaport). Final Office Action pp. 19-20. Applicant believes the new features and limitations of claim 36 are outside the scope of the of the combination of cited art, as discussed above. Therefore, Applicant respectfully requests that the rejection be withdrawn.

Sixth Ground of Rejection

Claim 21 stands rejected under 35 U.S.C. § 103(a) over U.S. Patent Application Publication No. 2004/0260710 (hereinafter Marston) in view of U.S. Patent Application Publication No. 2004/0249650 (hereinafter Freedman), U.S. Patent Application Publication No. 2003/0233420 (hereinafter Stark), and U.S. Patent Application Publication No. 2006/0074727 (hereinafter Briere). Final Office Action pp. 20-21. Applicant believes the new features and limitations of claim 36 are outside the scope of the of the combination of cited art, as discussed above.

Additionally, claim 36 recites “responsive to determining that the search was not satisfactory, entering feedback by the user.” The Examiner rejected limitations similar to these in the Final Office Action. Final Office Action p.18 (rejecting claim 18). The Examiner admits

Marston, Freedman, and Stark fail to teach the similar limitations. Briere is silent to “that the search was not satisfactory” and is silent to “entering feedback” in response to “determining that the search was not satisfactory.” Hence, the combination of cited art fails to teach “responsive to determining that the search was not satisfactory, entering feedback by the user.”

Thus, the claim comprises features and limitations that are outside the scope of the cited art. Therefore, Applicant respectfully requests that the rejection be withdrawn.

Seventh Ground of Rejection

Claims 22, 31, and 34 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent Application Publication No. 2004/0260710 (hereinafter Marston) in view of U.S. Patent Application Publication No. 2004/0249650 (hereinafter Freedman), U.S. Patent Application Publication No. 2003/0233420 (hereinafter Stark), and U.S. Patent No. 7,177,817 (hereinafter Khosla). Final Office Action pp. 21-24. Applicant believes the new features and limitations of claim 36 are outside the scope of the of the combination of cited art, as discussed above. Therefore, Applicant respectfully requests that the rejection be withdrawn.

Eighth Ground of Rejection

Claims 22, 31, and 34 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent Application Publication No. 2004/0260710 (hereinafter Marston) in view of U.S. Patent Application Publication No. 2004/0249650 (hereinafter Freedman), U.S. Patent Application Publication No. 2003/0233420 (hereinafter Stark), and U.S. Patent Application Publication No. 2002/0059566 (hereinafter Delcambre). Final Office Action pp. 25-28. Applicant believes the new features and limitations of claim 36 are outside the scope of the of the combination of cited art, as discussed above. Therefore, Applicant respectfully requests that the rejection be withdrawn.

Ninth Ground of Rejection

Claims 23, 32, and 35 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent Application Publication No. 2004/0260710 (hereinafter Marston) in view of U.S. Patent Application Publication No. 2004/0249650 (hereinafter Freedman), U.S. Patent Application Publication No. 2003/0233420 (hereinafter Stark), and U.S. Patent Application Publication No. 2002/0188777 (hereinafter Kraft). Final Office Action pp. 28-31. Applicant believes the new features and limitations of claim 36 are outside the scope of the combination of cited art, as discussed above. Therefore, Applicant respectfully requests that the rejection be withdrawn.

Tenth Ground of Rejection

Claims 24-28, 30, and 33 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent Application Publication No. 2004/0260710 (hereinafter Marston) in view of U.S. Patent Application Publication No. 2004/0249650 (hereinafter Freedman). Final Office Action pp. 31-37. Applicant believes the new features and limitations of claim 36 are outside the scope of the combination of cited art, as discussed above. Therefore, Applicant respectfully requests that the rejection be withdrawn.

CONCLUSION

Applicant submits that the claims are now in condition for allowance.

Respectfully submitted,



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